Appln. Serial No. 09/775,238
Reply to Office Action Mailed August 7, 2007

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REMARKS

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In the Office Action dated August 7, 2007, claims 3-7, 10, 12-21, 23-25, and 27-33 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,636,502 (Lager) in view of "GPRS Tunnelling Protocol (GTP) Across the Gn and Gp Interface," 3G TS 29.060 V3.2.2 (1999-12) Specification (3G Specification) and U.S. Patent No. 6,535,511 (Rao).

The following discussion will focus on independent claim 4 as an exemplary claim.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as a recent U.S. Supreme Court held, it is **important** to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Here, the objective teachings of Lager, 3G Specification, and Rao indicate that a person of ordinary skill in the art would have found no reason to combine the teachings of Lager, 3G Specification, and Rao in the manner proposed by the Office Action. Therefore, it is respectfully submitted that the subject matter of claim 4 is non-obvious over the cited references.

Several points of error were made in the Office Action. First, the Office Action premised the obviousness rejection partly on the following finding: "see also Specification: p. 10, lines 21-31, which **defines** the PDP Context Create Request as a GTP packet." 8/7/2007 Office Action at 3 (emphasis added). The Specification of the present application made no such definition. The cited passage on page 10 of the Specification refers to a PDP Context Create Request being carried in an IP packet. The cited passage of the Specification notes that the IP packet contains a GTP PDU, which can carry the PDP Context Create Request. The cited passage of the Specification further notes that an IP packet that contains a GTP PDU can be referred to as GTP packet. Nowhere in this passage is there anything that would remotely **define** a PDP Context Create Request as a GTP packet.

To the extent that the Office Action is asserting that all PDP Context Create Request messages are carried as a GTP data unit in the payload portion of an IP packet, that assertion is wrong. In fact, Lager expressly states that PDP Context activation is used to "initiate[] the creation of a tunnel between a PDP context in a SGSN and a PDP context in a GGSN." Lager,

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6:52-56. This is further repeated in another passage of Lager, which refers to setting up a tunnel "by the PDP context activation." *Id.*, 8:24-25. Thus, the fact that Lager teaches that PDP context activation initiates the creation of a tunnel is contrary to the assertion that a Create PDP Context Request is a GTP packet. In Lager, since the tunnel is to be initiated by the PDP Context Create Request, that would mean that the PDP Context Create Request message of Lager would **not** be carried in a GTP data unit, since the GTP tunnel has not yet been established. Therefore, the Create PDP Context Request message of Lager is **not** a "GTP data unit" as recited in claim 4.

Moreover, the Office Action conceded that Lager fails to disclose the first IP packet of claim 4, which contains a header having a private network address and a payload portion containing the GTP data unit that also contains the private network address. 8/7/2007 Office Action at 3. However, the Office Action cited the 3G Specification as disclosing the claimed subject matter missing from Lager. *Id.*

It appears that the Office Action has mis-read the 3G Specification. With respect to the 3G Specification, the Office Action made the following observation: "p. 16, where the Create PDP Context Request, i.e. a GTP signaling message, contains the SGSN address for signaling purposes and where this address may be same as the address in the header ...." *Id.* It is noted that the actual teaching on page 16 of the 3G Specification is that the SGSN address for signaling and the SGSN address for user traffic "may **differ** from that provided by the underlying network service (e.g. IP)." What this would have suggested to a person of ordinary skill in the art would be that the Create PDP Context request can contain an address that is different from the IP address in the IP packet header. A person of ordinary skill in the art looking at this teaching of the 3G Specification would have been taught that the issue of inconsistent addresses in the header and payload of an IP packet can be addressed by using a Create PDP Context request that has an address different from the IP address provided by the underlying network service. That would have actually led **away** from the claimed invention, since providing the different address in the Create PDP Context request of Lager and the 3G Specification would have rendered the translation of private network addresses in both the header and payload portion unnecessary.

A further point of error made by the Office Action is the assertion that it would have been obvious to combine Lager and the 3G Specification "to increase the industrial applicability of Lager's system by having the Create PDP Context Request message of Lager comply with the

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requirements of the 3G Specification." 8/7/2007 Office Action at 4. There is no requirement of the 3G Specification that the PDP Context Create Request message carried by an IP packet must contain the same private network address as the header of the IP packet. In fact, the opposite is suggested by the 3G Specification, namely that the SGSN address for signaling and SGSN address for user traffic contained in the Create PDP Context Request message "may differ from that provided by the underlying network service (e.g. IP)." A person of ordinary skill in the art reading the 3G Specification would have realized that a solution to the problem of inconsistent addresses at the receiving end could be resolved by incorporating an address in the PDP Create Context request message that is different from the header of the IP packet. Thus, clearly, rather than encourage a person of ordinary skill in the art to implement the claimed invention, the teachings of the 3G Specification would have encouraged the person of ordinary skill in the art to implement a different solution. In any event, the statement in the Office Action that the proposed combination of Lager and the 3G Specification would have increased the industrial applicability of Lager's system by complying with the requirements of the 3G Specification is based on an erroneous reading of the "requirements" of the 3G Specification.

In view of the objective teachings of Lager and the 3G Specification, it is clear that persons of ordinary skill in the art at the time of the present invention did not even recognize the issue of having a private network address in both the header and payload portion of an IP packet in a wireless network environmnet. Therefore, the Office Action's citation of Rao as providing a reason to modify the teachings of Lager and the 3G Specification is erroneous. It is clear that the Office Action has engaged in impermissible hindsight in applying the teachings of Rao, which are related to wired networks, to the teachings of Lager and the 3G Specification, which provide objective evidence that a person of ordinary skill in the wireless art would clearly not have recognized any need to use the techniques of Rao. As warned by the U.S. Supreme Court, impermissible hindsight reconstruction cannot be used to combine reference teachings. See Graham v. John Deere Co., 383 U.S. at 36 (noting the inappropriateness of slipping into the use of hindsight in rendering an obviousness rejection). In this case, as discussed above, Lager and the 3G Specification would have taught a solution that would be contrary to the techniques of Rao – namely, Lager and the 3G Specification would have taught that the Create PDP Context Request message would use a different address than the IP packet header so that address translation would not be needed for the payload portion of the IP packet.

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In view of the foregoing, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness.

The remaining independent claims (3, 5, 10, 18, 25) are allowable for similar reasons as claim 4. Moreover, dependent claims are allowable for at least the same reasons as corresponding independent claims.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0090US).

Respectfully submitted,

Date: _Nov 7, 2007_

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